

REMARKS

APPLICANT'S RECORD OF EXAMINER INTERVIEW

On July 7, 2005, Applicant's Counsel Lawrence E. Crowe contacted Examiner Gay Spahn regarding the restriction requirement, and expresses appreciation for the courtesy extended by Examiner Spahn during the interview. Applicant's Counsel contacted the Examiner to inquire as to why the restriction had been issued at this point in prosecution, given that there have been two Office Actions on the merits by the Examiner previously assigned to the case, with no restriction being required by the previous Examiner. Examiner Spahn responded that, had she been handling the Application from the start of prosecution, she would have issued a restriction requirement at the outset of prosecution, and since she now had responsibility for the case, she was going to proceed in the manner that she would have proceeded if she had been the Examiner of record at the outset of prosecution.

ELECTION WITH TRAVERSE

Pursuant to 35 U.S.C. §121, the Office Communication mailed June 7, 2005 requires restriction of the claim set comprising claims 1 through 23 to a group of claims comprising one of two inventions identified in the Office Action. The Office Action groups the claims into the following to groups: claims 1-16 and 17-20 (Group I), and claims 21-23 (Group II).

The Restriction Requirement is respectfully traversed for the reasons set forth in the following paragraphs. However, **Group I**, consisting of **claims 1-16 and 17-20**, is provisionally elected. Applicant submits that new claims 24 and 25 would also be grouped into Group I, in keeping with the Examiner's rationale as stated in the Office Communication.

The Restriction Requirement is improper for the following reasons:

1. Pursuant to the provisions of MPEP § 704.01, "[w]hen an Examiner is assigned to act on an Application which has received one or more actions by some other Examiner, full faith and credit should be given to the search and action of the previous Examiner unless there is a clear error in the previous action or knowledge of other prior art. In general, the second Examiner should not take an entirely new approach to the Application or attempt to reorient the point of view of the previous Examiner, or make a new search in the mere hope of finding something." Examiner Spahn has not alleged any clear error on the part of the previous Examiner, and therefore should give full faith and credit to the search and action of the previous Examiner.

2. No additional search should be required to proceed with prosecution of all of claims 1-23, or new claims 24-25. Any search required to examine claims 1-23, without restriction, has presumably already been performed by the Examiner previously assigned to the case, prior to issuing the previous two non-final Office Actions on the merits of claims 1-23. New claims 24 and 25 should also fall within the scope of the previous searches.

3. It cannot be shown by the Examiner that a search and examination of the entire Application causes a serious burden as required by Section 803 of the MPEP. Accordingly, the Examiner must proceed with examination of all claims, even if they are directed to independent or distinct inventions.

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and

(B) **There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).**

MPEP § 803 at page 800-4 (Emphasis added).

Contrary to the requirements for a proper Restriction Requirement, maintaining the Restriction Requirement in the present Application places a “serious burden” on the operation of the Patent Office, the public and the applicants. Filing additional Applications directed to the non-elected inventions unnecessarily burdens the Patent Office because it must assume the additional and unnecessary labor involved in examining separate Applications. The public is burdened because it has to locate and review at least two patents (due to the further restriction of an individual species) instead of one in order to fully ascertain the scope of the patent protection provided the subject matter in the specification. Finally, the applicant is burdened because he must bear the expense of filing and prosecuting multiple applications. This last consideration is particularly severe in this Application, because the inventor has a limited budget for prosecution of his patent Application.

In contrast to the burdens to the ongoing operation of the Patent Office, the public and the applicants, the burden of examining all of the claims currently pending in the Application, instead of just one group of the claims, is negligible. In this regard, any additional searches

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Application No.: 10/680,059

that the newly assigned Examiner must conduct for the two groups of claims are likely to overlap. In fact, a complete search of the claims for Group I is likely to include all, or at least most, of the field of search for the claims of Group II, given that, as correctly stated by the Examiner in her restriction Requirement, "[i]nventions I and II are related as process and apparatus for its practice." Therefore, any additional search that may be required for Groups I and II should not create a serious burden for the Examiner.

CONCLUSION

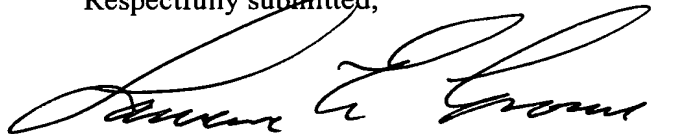
For the reasons stated above, it is respectfully submitted that Groups I and II should not be subject to a Restriction Requirement.

The Restriction Requirement should be withdrawn and all of the claims examined for compliance with regard to the relevant requirements of the patent statutes, rules and regulations. The Examiner is respectfully requested to examine all of the claims.

In any event, the Applicant has provisionally elected, with traverse, the claims of Group I in the Office Communication as identified above.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject Application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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